

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner took the following actions:

rejected claims 7, 9, 10, 12, 15, 16, 36, 38, 39, 41, 44, and 45 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,867,821 to Ballantyne et al. ("*Ballantyne*") in view of U.S. Patent No. 5,740,231 to Cohn et al. ("*Cohn*");

rejected claims 7, 9, 10, 12, 15, 16, 36, 38, 39, 41, 44, and 45 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,269,402 to Lin et al. ("*Lin*") in view of U.S. Patent No. 5,740,231 to Cohn et al. ("*Cohn*");

rejected claims 1-3, 5, 8, 13, 30-32, 34, 37, 42, 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over *Ballantyne* in view of *Cohn* and further in view of U.S. Patent No. 5,805,666 to Ishizuka et al. ("*Ishizuka*");

rejected claims 1-3, 5, 8, 13, 30-32, 34, 37, 42, 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over *Lin* in view of *Cohn* and further in view of U.S. Patent No. 5,805,666 to Ishizuka et al. ("*Ishizuka*");

rejected claims 11, 14, 17, 40, 43, 46, and 51-53 under 35 U.S.C. § 103(a) as being unpatentable over *Lin* in view of *Cohn* and further in view of *Ballantyne*; and

rejected claims 4, 6, 33, 35, 48, 50, and 54 under 35 U.S.C. § 103(a) as being unpatentable over *Lin* in view of *Cohn* and *Ishizuka*, and further in view of *Ballantyne*.

By the present amendment Applicant amends claims 1, 3, 7, 12, 30, 32, 36, 41, and 51. Claims 1-17 and 30-54 remain pending in this application.

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<sup>1</sup> As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

**Rejections of Claims 1-17 and 30-54 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 7, 9, 10, 12, 15, 16, 36, 38, 39, 41, 44, and 45 under 35 U.S.C. § 103(a) as being unpatentable over *Ballantyne* in view of *Cohn* because a prima facie case of obviousness has not been established with respect to the claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P. § 2145*. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P. § 2143.01(III), internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the

prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Independent claim 7 recites a method of accessing an information system using a portable access device including, among other steps, "establishing a communication link between said portable access device and said network server using a communication channel that is selected **based on said communication profile, a location of said portable access device with respect to said network server, a desired quality of the communication link, and a cost of the communication link.**" (Emphasis added).

On page 4 of the Office Action, the Examiner concedes that *Ballantyne* does not explicitly teach a communication profile and establishing a communication link between said portable access device and said network server using a communication channel that is selected based on said communication profile and a location of said portable access device with respect to said network server. The Office Action relies on *Cohn* to overcome this deficiency of *Ballantyne*. This, however, is incorrect.

*Cohn* is directed to "a communication system 10 [that] maintains a universal database of all users of the communications system and their individual communications profiles including the various media in which the users can send and receive messages. For example, a single user may control and receive communications using an electronic mail facility, a voice mail facility, a facsimile facility and a video facility." (*Cohn*, col. 7, line 62-col. 8, line 7). In *Cohn*, network hubs 12, 14, and 16 use the universal database to translate a message in accordance with the

communication profiles and the translated message is then routed to a destination facility. (*Cohn*, col. 8, line 6-col. 9, line 12).

Thus, *Cohn* discloses the use of communication profiles to translate and route messages to a destination facility. Using communication profiles to translate and route messages, however, does not constitute selecting a communication channel “based on said communication profile, a location of said portable access device with respect to said network server, a desired quality of the communication link, and a cost of the communication link,” as recited in claim 7. This is at least because there is no disclosure in *Cohn* of selecting a communication channel based on “a desired quality of the communication link . . . and a cost of the communication link,” as recited in claim 7. The communication profiles of *Cohn* merely include information regarding various media which users can use to send and receive messages, but do not include any information regarding “a desired quality of the communication link” or “a cost of the communication link.”

Moreover, combinations of *Ballantyne* and *Cohn* do not teach or suggest “using the selected communication channel when no user action is required to establish the communication link . . . and displaying a notification to instruct a user to perform a user action to establish the communication link when the user action is required to establish the communication link,” as further recited in claim 7.

Thus, *Ballantyne* and *Cohn* do not teach, suggest, or render obvious the features of claim 7.

Accordingly, for at least the above reasons, the Office Action has not established a *prima facie* case of obviousness for claim 7. Thus, the rejection of claim 7 under 35 U.S.C. § 103(a) should be withdrawn.

Independent claims 12, 36, and 41, while of different scope, recite features similar to those of claim 7 and are thus also allowable over *Ballantyne* and *Cohn* for reasons similar to those presented above for claim 7. For example, claim 12 includes "establishing a communication link between said portable access device and said second network server using a communication channel that is selected based on said communication profile, a location of said portable access device with respect to said second network server, a desired quality of the communication link, and a cost of the communication link;" claim 36 includes "establishing a communication link between said portable access device and said network server using one of a plurality of communication channels that is selected based on said communication profile, a location of said portable access device with respect to said network server, a desired quality of the communication link, and a cost of the communication link;" and claim 41 includes "establishing a communication link between said portable access device and said second network server using a communication channel that is selected based on said communication profile, a location of the portable access device with respect to said second network server, a desired quality of the communication link, and a cost of the communication link," features that are not taught or suggested by *Ballantyne* and *Cohn*.

Claims 9, 10, 15, 16, 38, 39, 44, and 45 are also allowable at least due to their dependence from one of the independent claims.

Accordingly, reconsideration and withdrawal of this rejection of claims 7, 9, 10, 12, 15, 16, 36, 38, 39, 41, 44, and 45 under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.

Applicant respectfully traverses the rejection of claims 7, 9, 10, 12, 15, 16, 36, 38, 39, 41, 44, and 45 under 35 U.S.C. § 103(a) as being unpatentable over *Lin* in view of *Cohn* because a prima facie case of obviousness has not been established with respect to the claims.

As discussed above, independent claim 7 recites a method of accessing an information system using a portable access device including, among other steps, "establishing a communication link between said portable access device and said network server using a communication channel that is selected **based on said communication profile, a location of said portable access device with respect to said network server, a desired quality of the communication link, and a cost of the communication link.**" (Emphasis added).

On page 8 of the Office Action, the Examiner concedes that *Lin* does not explicitly teach a communication profile and establishing a communication link between said portable access device and said network server using a communication channel that is selected based on said communication profile and a location of said portable access device with respect to said network server. The Office Action relies on *Cohn* to overcome this deficiency of *Cohn*. This, however, is incorrect.

As noted above, *Cohn* discloses the use of communication profiles to translate and route messages to a destination facility, but does not teach, suggest, or render obvious selecting a communication channel "based on said communication profile, a

location of said portable access device with respect to said network server, a desired quality of the communication link, and a cost of the communication link," as recited in claim 7.

Moreover, combinations of *Lin* and *Cohn* do not teach or suggest "using the selected communication channel when no user action is required to establish the communication link . . . and displaying a notification to instruct a user to perform a user action to establish the communication link when the user action is required to establish the communication link," as further recited in claim 7.

Thus, *Lin* and *Cohn* do not teach, suggest, or render obvious the features of claim 7.

Accordingly, for at least the above reasons, the Office Action has not established a *prima facie* case of obviousness of claim 7. Thus, the rejection of claim 7 under 35 U.S.C. § 103(a) should be reversed.

Independent claims 12, 36, and 41, while of different scope, recite features similar to those of claim 7 and are thus also allowable over *Lin* and *Cohn* for reasons similar to those presented above for claim 7. Claims 9, 10, 15, 16, 38, 39, 44, and 45 are also allowable at least due to their dependence from one of the independent claims.

Accordingly, reconsideration and withdrawal of this rejection of claims 7, 9, 10, 12, 15, 16, 36, 38, 39, 41, 44, and 45 under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.

Applicant respectfully traverses the rejection of claims 1-3, 5, 8, 13, 30-32, 34, 37, 42, 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over *Ballantyne* in

view of *Cohn* and further in view of *Ishizuka* because a prima facie case of obviousness has not been established.

Independent claims 1, 3, 30, and 32, while of different scope, recite features similar to those of claim 7. For example, claim 1 includes "attempting, by the portable access device, to establish a communication link between the portable access device and the first network server using communication channel that is selected by the portable access device based on the communication profile, a location of the portable access device with respect to the first network server, a desired quality of the communication link, and a cost of the communication link . . . establishing the communication link by using the selected communication channel when no user action is required to establish the communication link . . . and displaying a notification to instruct a user to perform a user action to establish the communication link when the user action is required to establish the communication link;" claim 3 includes "attempting, by the portable access device, to establish a communication link between the portable access device and the first network server using one of a plurality of communication media, in accordance with the communication profile, a desired quality of the communication link, and a cost of the communication link . . . establishing the communication link by using the selected communication media when no user action is required to establish the communication link . . . and displaying a notification to instruct a user to perform a user action to establish the communication link when the user action is required to establish the communication link;" claim 30 includes "attempting, by the portable access device, to establish a communication link between the portable access device and the first network server using a communication channel that is selected by



the portable access device based on the communication profile, a location of the portable access device with respect to the first network server, a desired quality of the communication link, and a cost of the communication link . . . establishing the communication link by using the selected communication channel when no user action is required to establish the communication link . . . and displaying a notification to instruct a user to perform a user action to establish the communication link when the user action is required to establish the communication link;" and claim 32 includes "attempting, by the portable access device, to establish a communication link between the portable access device and the first network server using one of a plurality of communication media, in accordance with the communication profile, a desired quality of the communication link, and a cost of the communication link . . . establishing the communication link by using the selected communication channel when no user action is required to establish the communication link . . . and displaying a notification to instruct a user to perform a user action to establish the communication link when the user action is required to establish the communication link," features that are not rendered obvious in view of combinations of *Ballantyne* and *Cohn* for at least the above discussed reasons.

In addition, *Ishizuka* fails to cure the above-noted deficiencies of *Ballantyne* and *Cohn*. Thus, independent claims 1, 3, 30, and 32 and their respective dependent claims are allowable over the cited references.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-3, 5, 8, 13, 30-32, 34, 37, 42, 47, and 49 under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.

Applicant respectfully traverses the rejection of claims 1-3, 5, 8, 13, 30-32, 34, 37, 42, 47, and 49 under 35 U.S.C. § 103(a) as being unpatentable over *Lin* in view of *Cohn* and further in view of *Ishizuka* because a prima facie case of obviousness has not been established.

As discussed, independent claims 1, 3, 30, and 32, while of different scope, recite features similar to those of claim 7. As also discussed above, *Lin* and *Cohn* do not teach, suggest, or render obvious the features of claim 7. In addition, *Ishizuka* fails to cure the above-noted deficiencies of *Lin* and *Cohn*. Thus, independent claims 1, 3, 30, and 32 and their respective dependent claims are allowable over the cited references.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-3, 5, 8, 13, 30-32, 34, 37, 42, 47, and 49 under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.

Applicant respectfully traverses the rejection of claims 4, 6, 11, 14, 17, 33, 35, 40, 43, 46, 48, and 50-54 under 35 U.S.C. § 103(a) as being unpatentable over combinations of *Lin*, *Cohn*, *Ballantyne*, and/or *Ishizuka* because a prima facie case of obviousness has not been established.

Independent claim 51, while of different scope, recites features similar to those of claim 7. For example, independent claim 51 includes "attempting, by the access device, to establish a communication link between the access device and the first server, in accordance with the communication profile, a desired quality of the communication link, and a cost of the communication link . . . establishing the communication link when no user action is required to establish the communication link . . . [and] displaying a

notification to instruct a user to perform a user action to establish the communication link when the user action is required to establish the communication link," features that are not rendered obvious in view of combinations of *Lin*, *Cohn*, *Ballantyne*, and *Ishizuka* at least because of the above discussed reasons. Thus, independent claims 1, 3, 7, 12, 30, 32, 36, 41, and 51 and their respective dependent claims are allowable over the cited references.

Accordingly, reconsideration and withdrawal of this rejection of claims 4, 6, 11, 14, 17, 33, 35, 40, 43, 46, 48, and 50-54 under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.

### **CONCLUSION**

In view of the foregoing amendment and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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